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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.			DELCOTTO, GREGORY R	
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ALEXANDRIA, VA 22314			1796	
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			11/28/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

Application No.

10/500,469

Applicant(s)

AIHARA ET AL.

Examiner

Gregory R. Del Cotto

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on RCE filed 9/14/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3 and 12-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 3 and 12-16 are pending. Claims 1, 2, 4-11, and 17 have been canceled. Applicant's arguments and amendments filed 9/14/07 have been entered.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/14/07 has been entered.

#### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### **Objections/Rejections Withdrawn**

The following objections/rejections as set forth in the Office action mailed 6/14/07 have been withdrawn:

The rejection of claim 17 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement has been withdrawn.

The rejection of claim 17 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, has been withdrawn.

#### ***Claim Rejections - 35 USC § 112***

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 12-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 3, it is vague and indefinite in that the claim recites that the molar ratio of A/A+B is from 2/3 to 0.9 while the claim also recites that the monomer unit A can be present in an amount of 100 mol% which is not possible based on the recited ratio. Clarification is required. Note that, for purposes of examination, the Examiner has interpreted the claim based on the recited molar ratio. Note that, claims 12-16 have also been rejected due to their dependency on claim 3.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

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by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aubay et al (6,593,288) in view of Pucci et al (US 5,872,088) or Aubay et al (US 6,703,358).

'288 teaches the use of a water-soluble or water-dispersible copolymer comprising monomers including dimethyldiallylammonium chloride, at least one hydrophilic monomer, and optionally at least one hydrophilic monomer compound containing ethylenic unsaturation and of neutral charge, on hard surfaces to give a hard surface hydrophilic properties. See Abstract. The molar ratio of dimethyldiallylammonium chloride monomer to hydrophilic monomer is from 60:40 to 5:95. Note that, the Examiner asserts that it would have been obvious to one of ordinary skill in the art to use a polymer having molar ratio of monomer A to monomer A plus monomer B of 0.666, as recited by the instant claims, in the composition taught by Aubay et al, with a reasonable expectation of success, because one skilled in the art would have an expectation of similar properties when using a polymer having a molar ratio of 0.666 based on a teaching of a molar ratio of 0.6 by Aubay et al. Note that, a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected

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them to have the same properties. Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). See MPEP 2144.05.

The copolymer preferably has a molecular weight of at least 1000, advantageously of at least 10,000. See column 3, lines 35-45. The copolymers are used in compositions for cleaning ceramics such as bathrooms, sinks, shower walls, toilet pans, etc. See column 5, lines 40-55. The polymers containing DADMAC have hydrophilic properties to give the hard surface long-lasting hydrophilic properties so as to avoid the subsequent presence of marks due in particular to the drying of droplets of water deposited on said surface. See column 1, lines 5-15. Additionally, the compositions contain surfactants. See column 11, lines 50-65. Specifically, '288 teaches a detergent formulation for cleaning hard surfaces such as tiles, sinks, baths, etc. containing 24% sodium sulfonate, 5% ethoxylated C12 fatty alcohol, 4% ethanol, polymer, and water. Note that, the Examiner asserts that the teachings of '288 suggest compositions having the same antifouling properties as recited by the instant claims because '288 suggest compositions containing the same components in the same proportions as recited by the instant claims.

'288 does not teach a method of antifouling and washing hard surfaces of toilet bowls using a composition containing the specific cationic polymer, surfactant, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Pucci et al teach hard surface cleaning compositions which are viscous but at the same time easy to rinse. Such compositions are formulated by using a linear C6-C16

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alcohol and/or linear alkoxylated C6-C16 alcohol, a hydrotropic solvent, and an anionic surfactant. See Abstract. An advantage of the viscous compositions is that they may be used in a wide range of applications in bathrooms, kitchens, floors, and especially on any vertical surface like walls, toilet bowls, and the like. See column 2, lines 5-15. The compositions of the present invention comprise from 0.1% to 20% by weight of the total compositions of said linear alcohol. See column 3, lines 30-40.

Aubay et al teach a cleaning composition for hard surfaces including ceramic, tile or glass-type comprising at least one surfactant and a water soluble or water-dispersible copolymer. See Abstract and column 1, lines 1-5. The copolymer according to the invention advantageously has a weight-average molecular mass of at least 1000 up to 10,000,000. See column 3, lines 1-10. The composition may also be used for cleaning toilet bowls and includes from 0.05% to 5% by weight of a water-soluble or water-dispersible copolymer, from 0.1 to 40% by weight of an inorganic acid cleaning agent, from 0.5 to 10% by weight of a surfactant, from 0.1 to 3% by weight of a thickener, and additives. See claim 6.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use the composition as taught by '288 to clean toilet bowls, with a reasonable expectation of success, because '358 or Pucci et al teach the use of a similar composition for cleaning hard surfaces in general including toilet bowls and further, '288 teaches the cleaning of bathroom hard surfaces in general which would encompass toilet bowls.



It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to antifoul and wash hard surfaces of toilet bowls using a composition containing the specific cationic polymer, surfactant, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success, because the broad teachings of '288 in combination with '358 or Pucci et al suggest a method of antifouling and washing hard surfaces of toilet bowls using a composition containing the specific cationic polymer, surfactant, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Claims 3 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pucci et al (US 5,872,088) or Aubay et al (US 6,703,358), both in view of Aubay et al (US 6,593,288).

Pucci et al or '358 are relied upon as set forth above. However, neither reference teaches the use of the specific polymer or a method of cleaning a toilet bowl using a composition containing the specific cationic polymer, surfactant, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious to use the specific polymer containing DADMAC monomer in the composition taught by Pucci et al or '358, with a reasonable expectation of success, because '288 teaches the advantageous non-spotting properties imparted to a similar hard surface cleaning composition when using the specific polymer containing DADMAC monomer, and further, such non-spotting properties would be

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aesthetically desirable for toilet bowl cleaning compositions as taught by Pucci et al or '358.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to antifoul and wash hard surfaces of toilet bowls using a composition containing the specific cationic polymer, surfactant, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success, because the broad teachings of '358 or Pucci et al, both in combination with '288 suggest a method of antifouling and washing hard surfaces of toilet bowls using a composition containing the specific cationic polymer, surfactant, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

### ***Response to Arguments***

With respect to Aubay et al ('288), Applicant states that this reference teaches a polymer in which the ratio of monomer A/monomer A + monomer B does not exceed 0.5 while the claimed method uses a polymer in which the A/A+B ratio is 0.666 to 0.9. In response, note that, the Examiner maintains that '288 clearly teaches polymers in which the molar amount of quaternized amine exceeds that of a second polymerizable monomer since '288 teaches that the polymer has a molar ratio of a/b of 60/40. See Abstract. This would correspond to a molar ratio of A/(A+B) or 60/40+60 of 0.6. As set forth above, the Examiner asserts that it would have been obvious to one of ordinary skill in the art to use a polymer having molar ratio of monomer A/monomer A + monomer B of 0.666, as recited by the instant claims, in the composition taught by Aubay et al,

with a reasonable expectation of success, because one skilled in the art would have an expectation of similar properties when using a polymer having a molar ratio of 0.666 based on a teaching of a molar ratio of 0.6 by Aubay et al. Note that, a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). See MPEP 2144.05.

Additionally, the Examiner maintains that the broad teachings of '288 in combination with Pucci et al or '358 are sufficient to render the instant claims obvious under 35 USC 103(a). Pucci et al and '358 are secondary references relied upon for their teaching of the use of a similar cleaning composition on toilet bowl surfaces. The Examiner maintains that one of ordinary skill in the art clearly would have been motivated to use the composition as taught by '288 to clean toilet bowls, with a reasonable expectation of success, because '358 or Pucci et al teach the use of a similar composition for cleaning hard surfaces in general including toilet bowls and further, '288 teaches the cleaning of bathroom hard surfaces in general which would encompass toilet bowls. Also, with respect to the rejection of the instant claims under 35 USC 103(a) using Pucci et al or '358, both in view of '288, the Examiner maintains that one of ordinary skill in the art clearly would have been motivated to use the specific polymer containing DADMAC monomer in the composition taught by Pucci et al or '358, with a reasonable expectation of success, because '288 teaches the advantageous non-spotting properties imparted to a similar hard surface cleaning composition when

using the specific polymer containing DADMAC monomer, and further, such non-spotting properties would be aesthetically desirable for toilet bowl cleaning compositions as taught by Pucci et al or '358.

Furthermore, Applicant states that comparative data is presented in the instant specification and in a Declaration filed under 37 CFR 1.132 which shows the unexpected and superior properties of the claimed invention in comparison to compositions falling outside the scope of the claimed invention. First, note that, as stated above, '288 suggests the same polymers as recited by the instant claims and thus, compositions formulated with such polymers would be expected to have the same antifouling properties as recited by the instant claims. Additionally, as stated previously, the data presented in Tables 1 and 2 of the instant specification and Declaration filed under 37 CFR 1.132 is not commensurate in scope with the claimed invention. The instant claims encompass thousands of different polymers having a wide range of molecular weights containing monomers A and B and are open to any amount of the polymer while the data presented in specification and 1.132 Declaration is limited to several polymers (2) at several specific weight percents (0.5%, 0.02%, 0.2%, 1%, 2%, and 5%) and molecular weights (Polymer A: 60,000; Polymer B; 30,000) which is not commensurate in scope with the claimed invention.

Further, as stated previously, with respect to the comparative examples such as, for example, comparative example 1-3 and comparative example 2-3, these examples do not provide a true comparison to claimed invention. Comparative examples 1-3 and 2-3 do not contain any surfactant while Examples 1-1 thru 1-10 and Examples 2-1 thru

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2-8 all contain surfactant so it is not clear if the increased anti-fouling properties are attributed to the presence of the surfactant in combination with the polymer or just the polymer itself. Additionally, while the Declaration filed under 37 CFR 1.132 provides additional example 2-9 and comparative example 2-5, this data is also not persuasive. The data presented in example 2-9 is only one single embodiment of the claimed invention and is not commensurate in scope with the claimed invention for the reasons stated above. Thus, the Examiner asserts that the comparative data presented in the specification and Declaration filed under 37 CFR 1.132 is not sufficient to place the instant claims in condition for allowance.

### ***Conclusion***


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Remaining references cited but not relied upon are considered to be cumulative to or less pertinent than those relied upon or discussed above.

Applicant is reminded that any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Gregory R. Del Cotto  
Primary Examiner  
Art Unit 1796

GRD  
November 21, 2007